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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/807,411	03/24/2004	Frank Muir	08740001AA	3860	
30743	7590 08/29/2006		EXAMINER		
WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.			DANIELS, MATTHEW J		
SUITE 340			ART UNIT	PAPER NUMBER	
RESTON, V	A 20190		1732		
			DATE MAILED: 08/29/2004	DATE MAILED: 08/29/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief

Application No.	Applicant(s)	
10/807,411	MUIR, FRANK	
Examiner	Art Unit	
Matthew J. Daniels	1732	

	Matthew J. Daniels	1732					
The MAILING DATE of this communication appe	ars on the cover sheet with the c	orrespondence add	ress				
THE REPLY FILED 16 August 2006 FAILS TO PLACE THIS AF	PPLICATION IN CONDITION FOR	ALLOWANCE.					
1. The reply was filed after a final rejection, but prior to or on this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliance time periods:	the same day as filing a Notice of ving replies: (1) an amendment, aff tice of Appeal (with appeal fee) in c	Appeal. To avoid aba idavit, or other evider compliance with 37 C	nce, which FR 41.31; or (3)				
a) The period for reply expires 3 months from the mailing date	of the final rejection.						
The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.							
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).							
Extensions of time may be obtained under 37 CFR 1.136(a). The date have been filed is the date for purposes of determining the period of extender 37 CFR 1.17(a) is calculated from: (1) the expiration date of the set forth in (b) above, if checked. Any reply received by the Office later may reduce any earned patent term adjustment. See 37 CFR 1.704(b) NOTICE OF APPEAL	tension and the corresponding amount shortened statutory period for reply origi than three months after the mailing da	of the fee. The appropri inally set in the final Offi	iate extension fee ce action; or (2) as				
 The Notice of Appeal was filed on A brief in comp filing the Notice of Appeal (37 CFR 41.37(a)), or any exter a Notice of Appeal has been filed, any reply must be filed 	nsion thereof (37 CFR 41.37(e)), to	avoid dismissal of th	ns of the date of e appeal. Since				
AMENDMENTS	F						
3. The proposed amendment(s) filed after a final rejection, (a) They raise new issues that would require further co(b) They raise the issue of new matter (see NOTE belo	nsideration and/or search (see NO		ecause				
(b) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or							
(d) They present additional claims without canceling a	corresponding number of finally rej	ected claims.					
NOTE: (See 37 CFR 1.116 and 41.33(a)).	21. See attached Nation of Non-Ca	maliant Amandmant	(DTOL 224)				
4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324). 5. Applicant's reply has overcome the following rejection(s):							
 Newly proposed or amended claim(s) would be al non-allowable claim(s). 	lowable if submitted in a separate,	timely filed amendme	ent canceling the				
7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is protected. The status of the claim(s) is (or will be) as follows:		ll be entered and an e	explanation of				
Claim(s) allowed:							
Claim(s) objected to: Claim(s) rejected: <u>1-4,7-11,17 and 18</u> .							
Claim(s) rejected. <u>1-4,7-11,17 and 18.</u> Claim(s) withdrawn from consideration:							
AFFIDAVIT OR OTHER EVIDENCE							
 The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good and was not earlier presented. See 37 CFR 1.116(e). 	t before or on the date of filing a North date of the affidate	otice of Appeal will <u>no</u> rit or other evidence is	ot be entered s necessary and				
9. The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to of showing a good and sufficient reasons why it is necessary	vercome all rejections under appe	al and/or appellant fai	ils to provide a				
10. ☐ The affidavit or other evidence is entered. An explanatio REQUEST FOR RECONSIDERATION/OTHER	n of the status of the claims after e	ntry is below or attach	ned.				
11. The request for reconsideration has been considered bu See the enclosed response to arguments.	t does NOT place the application in	n condition for allowa	nce because:				
12. Note the attached Information Disclosure Statement(s).	(PTO/SB/08 or PTO-1449) Paper N	lo(s)					
13.							

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Response to Arguments

Applicant's arguments, see page 4, lines 3-11, filed 16 August 2006, with respect to rejections under 35 USC 112, second paragraph, have been fully considered and are persuasive. The rejections of claims 1-4, 7-11, 17, and 18 under 35 USC 112, second paragraph have been withdrawn.

Applicant's arguments filed 16 August 2006 pertaining to the rejections under 35 USC 103(a) have been fully considered but they are not persuasive. Because the amendment does not introduce substantive change of scope of the claims, the grounds of rejection set forth previously is maintained. The arguments appear to be on the following grounds:

a) At no point does Owens show or describe making a plurality of lenses where different diameter lenses have different (radii) of curvature. Each is singular in nature. Pill bottles at pharmacies come in different sizes and Applicant's methodology allows mass production of caps b) the Owens device would never be made with a translucent material

These arguments are not persuasive for the following reasons:

a) Firstly, the Examiner maintains the position set forth previously, namely that Owens provides teaching and suggestion to select a particular size and shape according to that which is wanted in the finished element (32:30-31). Additionally, Owens teaches that different optical devices may be made, such as camera lenses, telescopes, and ophthalmic lenses (5:27, 6:23, 6:31), and the Examiner asserts that the ordinary artisan would find it prima facie obvious to make these lenses of different sizes, according to that which is wanted in the finished element. Secondly, it is unclear how this limitation distinguishes the claimed subject matter, because the claimed

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method of making is substantially the same as the method of making taught by Owens.

Thirdly, changes in size are generally insufficient to patentably distinguish an invention. See, for example, *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

b) The Examiner maintains the previous position regarding this argument. Namely, Applicant's own reference (coupled with the remarks filed 17 March 2006) shows that the word "translucent" may be defined as "2 transparent." See the portion shown below.

rans-lu-cent /tranzloosant, trans-/ adj. 1 allowing light to pass through diffusely; semitransparent. 2 transparent. 00 trans-lu-cence n. trans-lu-cency n. trans-lu-cent-ly adv.

The Examiner maintains the position that transparency and/or (see the definition above) translucency is inherent, and no distinction is apparent to the Examiner. Additionally, note Owens' teaching of "light-transmitting portion" at 14:18-19, which would appear to read on translucency.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Daniels whose telephone number is (571) 272-2450.

The examiner can normally be reached on Monday - Friday, 8:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJD 8/22/06

CHRISTINA JOHNSON PRIMARY EXAMINER

8/24/06